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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,629	10/15/2001	William R. Brown	00216-551001 / OB-199	2551
26161	7590	09/21/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			WALSH, JOHN B	
			ART UNIT	PAPER NUMBER
			3676	

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Km

<b>Office Action Summary</b>	<b>Application No.</b> 09/977,629	<b>Applicant(s)</b> BROWN ET AL.	
	<b>Examiner</b> John B. Walsh	<b>Art Unit</b> 3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19, 21-46 and 48 is/are pending in the application.
- 4a) Of the above claim(s) 18, 19 and 40-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 21-39, 44-46 and 48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>09202004</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 17 and 21-26, 37-39 and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,555,584 to Moore, III et al.

Moore '584 discloses a grip comprising a core (figure 6; 76) and a sheath (74), the sheath having a hardness greater than the core (core is a gel which is softer than the sheath).

As concerns claims 2 and 22, the core is an elastomeric material (column 4, lines 58-59).

As concerns claims 3 and 23, the elastomeric material is a thermoplastic elastomer (column 15, lines 10-13).

As concerns claims 4 and 24, the thermoplastic elastomer is a polyurethane (column 8, line 16 and 19).

As concerns claims 5, 6, 25 and 26, the core has a hardness of less than 50 and 25 Shore A (column 8, line 26).

As concerns claim 17, the claim is drawn to the method not the apparatus of a razor or toothbrush, wherein Moore '584 is capable of being used on a toothbrush or razor.

As concerns claim 21, a handle and grip (column 4, lines 62 and 66-67).

Art Unit: 3676

As concerns claims 37-39, the claim is drawn to a personal care product not a toothbrush, razor or hairbrush, wherein Moore '584 is capable of being used on a toothbrush, razor or hairbrush.

3. Claims 44-46 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,128,963 to Dano.

Dano '963 discloses a grip (13) comprising a first and second layer (material of 13 inherently has layers); a hollow core (figure 1) formed by injecting a gas into the middle of the first layer (column 5, lines 52-53).

As concerns claim 46, a foaming agent (column 7, lines 13-14).

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7-16 and 27-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,555,584 to Moore, III et al.

As concerns claims 7 and 27, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a shore hardness of less than 10A, since it has been held that discovering an optimum value as a result of effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Art Unit: 3676

As concerns claims 11-16 and 31-36, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the claimed ranges, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

As concerns claims 8-10 and 28-30, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the selected materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

#### *Allowable Subject Matter*

6. The indicated allowability of claims 1-19,21-46 and 48 is withdrawn in view of the newly discovered reference.

#### *Conclusion*

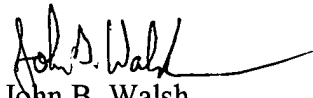
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 703-305-0444. The examiner can normally be reached on Monday-Friday from 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dan Stodola can be reached on 703-308-2686. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3676

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John B. Walsh  
Primary Examiner  
Technology Center 3670